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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,388

03/12/2004

Igor Seleznev

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CHOATE, HALL & STEWART LLP  
TWO INTERNATIONAL PLACE  
BOSTON, MA 02110

EXAMINER

WARTALOWICZ, PAUL A

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,388	<b>Applicant(s)</b> SELEZNEV ET AL.	
	<b>Examiner</b> PAUL A. WARTALOWICZ	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 12/12/07 have been fully considered but they are not persuasive.

Applicant argues that the plain language of the count requires heat-treating said precursor film at a temperature above about 700°C and that the language of the lost count is unambiguous and does not disclose any other temperature other than above 700°C.

However, the subject matter of the lost count sets forth heat-treating said precursor film (comprising barium, fluorine, yttrium, and copper) at a temperature above about 700°C in the presence of oxygen. One of ordinary skill in the art would recognize heat-treating would begin at room temperature and then rise to a temperature of above 700°C. As the temperature is increased to above 700°C, the precursor with oxygen present will be processed at a temperature of 400°C that will inherently form an oxyfluoride film which wherein the temperature is subsequently raised to a temperature of above 700°C in order to convert the oxyfluoride precursor to the superconducting material. It is stated in the specification that this is believed to be the mechanism that occurs during treatment of the precursor with oxygen at elevated temperatures (2005/0014652 [0036] and 2004/0171494 [0035]). Therefore, the specification supports the assertion that the oxyfluoride precursor film is formed in the process of the subject matter of the lost count. It appears that applicant's argument is focused on the recitation of forming a precursor film comprising barium, fluorine, yttrium, and copper.

However, as discussed above, it is maintained that the oxyfluoride precursor is inherently formed by the process conditions.

It appears that the specification describes the formation of the intermediate metal oxyfluoride compound as the mechanism by which the invention, and therefore the lost count, is carried out.

Applicant similarly argues that the time the precursor would need to be heated is not disclosed in the subject matter of the lost count.

As stated above, it appears that the specification describes the formation of the intermediate metal oxyfluoride compound as the mechanism by which the invention, and therefore the lost count, is carried out.

Applicant argues that the examiner improperly references applicant's specification to support the assertion that an oxyfluoride precursor film is formed in the process of the subject matter of the lost count.

However, the specification is referenced only to demonstrate that the limitations present in the instant application are inherently present in the subject matter of the lost count.

Applicant argues that the pending claim limitations "producing an oriented oxide superconducting film," "substantially stoichiometric proportions," "converting a metal oxyfluoride into the oxide superconductor," and "under conditions that enable the removal of HF from the film surface."

However, the rejection is maintained for the reasons set forth in the rejection of record.

Applicant argues that claim 40 does not read on, and is therefore not generic to, the subject matter of the lost count as discussed above.

However, it is maintained that claims 40-62 are not patentably distinct from the subject matter of the sole count, the claims stand rejected as estopped on the merits by the applicant's loss in the interference and the that the subject matter of claims 40-62 is generic to the subject matter of the lost count.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 40-62 are rejected under 35 U.S.C. 102(g) over the sole lost count of Patent Interference No. 105,406.

Claims 40-62 correspond to the subject matter of the sole count of Patent Interference No. 105,406, as to which a judgment adverse to the applicant has been rendered. A losing party is barred on the merits from seeking a claim that would have

been anticipated or rendered obvious by the subject matter of the lost count. *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992); *Ex parte Tytgat*, 225 USPQ 907 (Bd. Pat. App. & Inter. 1985). See also MPEP §2308.03.

In this instance, because claims 40-62 are not patentably distinct from the subject matter of the sole count, the claims stand rejected as estopped on the merits by the applicant's loss in the interference. The subject matter of claims 40-62 is generic to the subject matter of the lost count. As per Example 2 in MPEP §2308.03, since the generic claim encompasses subject matter lost in the interference, the generic claim must be rejected as estopped on the merits by the loss in the interference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL A. WARTALOWICZ whose telephone number is (571)272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Wartalowicz  
February 23, 2008

/Steven Bos/  
Primary Examiner  
A.U. 1793